PATENTS
AAA-003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants	: William K. Slate II et al.
Application No.	: 09/990,402 Confirmation No.: 3669
Filed	: November 21, 2001
For	: ELECTRONIC SYSTEMS AND METHODS FOR DISPUTE MANAGEMENT
Art Unit	: 3621
Examiner	: Evens J. Augustin

New York, New York 10036
December 27, 2010

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REPLY BRIEF UNDER 37 C.F.R. § 41.41(a)

Sir:

Pursuant to 37 C.F.R. § 41.41(a), appellants are filing this Reply Brief in reply to the Examiner's Answer dated October 27, 2010 (hereinafter "the Examiner's Answer"), and in support of their appeal from the rejection of claims 1, 2, 4-30, 32-44, 60, 61, 63-89, 91-103, 119, 120, 122-148, and 150-162 in the Office Action dated December 16, 2009. Appellants previously filed an Appeal Brief on July 16, 2010 (hereinafter "Appeal Brief") in connection with this appeal.

REMARKS

I. Introduction

The Examiner's Answer maintains the § 103(a) rejections of claims 1, 2, 4-30, 32-44, 60, 61, 63-89, 91-103, 119, 120, 122-148, and 150-162* from the December 16, 2009 Office Action and restates the same grounds of rejection from that Office Action. The Examiner's Answer also provides a "Response to Arguments" section that attempts to rebut one of appellants' arguments made in the Appeal Brief in response to the § 103(a) rejections.

In this Reply Brief, appellants maintain that claims 1, 2, 4-12, 15-30, 32-44, 60, 61, 63-71, 74-89, 91-103, 119, 120, 122-130, and 133-148 and 150-162 are not obvious from Israel et al. U.S. Patent No. 6,766,307 (hereinafter "Israel") in view of Landry U.S. Patent Publication No. 2003/0014265 (hereinafter "Landry"). In addition, appellants maintain that claims 13, 14, 72, 73, 131, and 132 are not obvious from Israel in view of Landry in further view of Murray et al. U.S. Patent No. 5,023,851 (hereinafter "Murray").

In particular, the Examiner's Answer is insufficient as a matter of law to uphold the § 103(a) rejections of claims 1, 2, 4-30, 32-44, 60, 61, 63-89, 91-103, 119, 120, 122-148, and 150-162 for at least the

* In the Examiner's Answer, claims 1-12, 15-44, 47-103, 119-130 and 133-162 are listed as rejected or pending in the application (pg. 2, § 3). Appellants respectfully note that, of those claims listed, claims 3, 31, 52, 62, 90, 121, and 149 have been cancelled. In addition, claims 13, 14, 72, 73, 131 and 132 stand rejected in the application. Claims 45-51, 53-59, 104-110, 112-118, 163-169 and 171-177 are withdrawn from consideration but have not been cancelled.

reasons set forth in appellants' Appeal Brief. Appellants have filed this Reply Brief to address comments in the Examiner's Answer and to further demonstrate the patentability of pending claims 1, 2, 4-30, 32-44, 60, 61, 63-89, 91-103, 119, 120, 122-148, and 150-162.

For at least the reasons provided in the Appeal Brief and in this Reply Brief, appellants respectfully submit that the Board should find the rejections of claims 1, 2, 4-30, 32-44, 60, 61, 63-89, 91-103, 119, 120, 122-148, and 150-162 to be in error and should reverse those rejections.

II. The 35 U.S.C. § 103(a) Rejections

In the Appeal Brief, appellants provided at least two reasons why the § 103(a) rejections should be reversed. First, appellants argued that Israel and Landry, whether taken alone or in combination, fail to show or suggest a "case manager" user. In particular, the case manager of appellants' claims guides disputing parties through a dispute resolution process and is provided with management features for selecting a neutral to facilitate the dispute resolution process. Israel and Landry, on the other hand, refer to a "program manager" and "system clerk," respectively, who are incompatible with the claimed case manager. Second, appellants argued that Israel and Landry cannot be combined in the manner suggested by the Examiner. Specifically, Israel's program manager is a representative of one of the parties to the dispute and may perform functions such as submitting disputes and related information, while Landry's system clerk serves a purely administrative role and is prevented from accessing the particular dispute resolution services within which dispute

resolution takes place. Accordingly, appellants contended that Israel's program manager and Landry's system clerk cannot feasibly be combined to show a single entity, such as appellants' case manager.

Nevertheless, in the Examiner's Answer, the Examiner maintains the view that Israel's program manager is equivalent to appellants' case manager "in that the program manager does functions such as but not limited to adding users, modifying existing user data, transferring active cases from one user to another, activating users, modifying account registration data, browsing all disputes, generating detailed dispute reports, as well as other actions which are used by a manager of non-judicial dispute resolutions, and any combination of one or more of the foregoing." *See* Examiner's Answer, pg. 11, § 10. Appellants respectfully disagree.

The Examiner, by highlighting the functions of Israel's program manager, appears to contend that Israel's program manager is equivalent to appellants' case manager simply because the two titles contain the same word "manager." Yet, appellants respectfully submit that if one looks beyond mere semantics, significant and irreconcilable differences emerge between Israel's program manager and appellants' case manager. Chief amongst these differences is the fact that Israel's program manager <u>is a party to the dispute</u>. Appellants' independent claims, on the other hand, recite a case manager that guides <u>opposing parties</u> through the dispute resolution process. *See* Appeal Brief, pp. 18-19. Moreover, the Examiner concedes that "Israel did not explicitly teach a system in which another user provides guidance/management or support to a dispute resolution system." *See* Examiner's Answer, pg. 11, § 10.

As appellants' case manager features prominently as a third party in this guidance capacity, there can be no doubt that Israel's program manager is quite distinct from the claimed case manager.

In the Examiner's Answer, the Examiner also continues to assert that Landry makes up for this deficiency in Israel. The Examiner maintains the view that Landry's system clerk "performs similar functions to the case manager" as it "accepts the registration of mediators and arbitrators." *See* Examiner's Answer, pg. 12. As such, the Examiner contends that it would have been obvious to combine Israel's program manager and Landry's system clerk to show the feature of a third-party manager that "provides guidance/management or support to a dispute resolution system." *Id.* On this point too, the appellants respectfully disagree.

As appellants argued in the Appeal Brief, Landry's system clerk cannot be reconciled with the claimed case manager. Landry's system clerk is <u>specifically prohibited</u> from accessing the dispute resolution services, including Landry's two major dispute resolution subsystems. *See* Appeal Brief, pg. 21. Accordingly, Landry's system clerk cannot manage the dispute management process, as required by appellants' claims. In addition, while the Examiner reiterates, in the Examiner's Answer, that Landry's system clerk accepts the registration of mediators and arbitrators, nothing in Landry suggests the system clerk selects a neutral <u>for a particular dispute</u>. *See* Appeal Brief, pg. 23. Besides, enrolling neutrals into an ODR system is not the same as selecting a neutral to facilitate dispute resolution between a user and another party, as required by appellants' claims. *Id.*

Appellants also argued in the Appeal Brief that Israel's program manager and Landry's system clerk cannot feasibly be combined to show the claimed case manager. In particular, appellants pointed out that Israel's program manager is a party to the dispute while Landry's system clerk serves in a global, detached administrative role. Additionally, appellants noted that while Israel's program manager may perform functions such as submitting disputes and related information, Landry's system clerk is prevented from accessing the particular dispute resolution services within which dispute resolution takes place. *See* Appeal Brief, pg. 24. Accordingly, the combination of Israel's program manager and Landry's system clerk would result in an entity with mutually exclusive characteristics and responsibilities. To wit, the combination cannot both be a party to the dispute and a neutral third party, nor can the combination perform functions related to the dispute and yet be absolutely barred from accessing the dispute resolution services necessary to do so. Thus, the combination of Israel and Landry cannot show or suggest appellants' case manager. Unfortunately, the Examiner appears not to have addressed this point.

In sum, Israel and Landry at best refer to a traditional three-party dispute resolution process that involves the two disputing parties and a neutral (e.g., an arbitrator or mediator), where some dispute resolution features are automated. In contrast, appellants' claims provide a fourth party - a case manager – for guiding users through the dispute resolution process. The claimed case manager, as discussed above, is distinct from either Israel's program manager, Landry's system clerk, or the combination thereof. Accordingly, the Examiner's rebuttal

arguments are unconvincing and insufficient to maintain the § 103(a) rejections of claims 1, 2, 4-30, 32-44, 60, 61, 63-89, 91-103, 119, 120, 122-148, and 150-162.

III. Conclusion

In view of the foregoing, as well as the reasons set forth in the Appeal Brief, appellants respectfully request that the Board reverse the § 103(a) rejections of claims 1, 2, 4-30, 32-44, 60, 61, 63-89, 91-103, 119, 120, 122-148, and 150-162.

Appellants believe no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 06-1075 from which the undersigned is authorized to draw.

Respectfully submitted,

/David R. Wildman/

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